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IN THE

Supreme Court of the United States

October Term, 1958

No. 832

WILLIAM DUBILIER,

Petitioner,

vs.

THE UNITED STATES.

PETITIONER'S REPLY BRIEF

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1. Because the invention here involved is a complex electronic device—an ionized gas arc discharge tube circuit —petitioner urged that the trier of facts must, as a matter of law, accept undisputed testimony unless he has special knowledge in this field.

Petitioner, through an expert, established a *prima facie* case of infringement by taking each word of a claim and applying it word for word to respondent's accused structure. Respondent did not dispute any portion of this testimony through its experts.

Respondent agrees that petitioner's testimony, namely that "potential means • • •" is present in defendant's structure, is "the uncontradicted testimony of an expert witness" (page 8, lines 21-27, respondent's brief).

The Court of Claims, despite this undisputed testimony, concluded that respondent's device does not "respond", that is, does not contain "potential means in the output circuit for alternately starting and stopping the electric discharge in said device". (Decision page 3, line 23; respondent's brief, page 8, line 17.)

Respondent in effect urges that despite this undisputed testimony, the trier of fact must have "freedom" to make findings contrary to the evidence. (Respondent's brief, page 7, line 6 from bottom.) But in the case he cites (page 8) there was contradictory testimony. This Court refused to disturb the finder's relative evaluation of such conflicting testimony. The petition on page 5 notes the distinction over conflicting testimony.

A limited number of people have knowledge in this involved electronic art,—a field in which knowledge depends upon familiarity with specific scientific principles not usually contained in the general storehouse of knowledge and experience.*

This case is thus distinguishable from a situation where the finder's own knowledge, or where common knowledge, justifies his right to ignore the testimony. Here the finder cannot rely on his own knowledge in the absence of personal qualifications as an expert in this field.

The reasonable assumption where material testimony in a technical matter is not disputed by opposing experts is that the opposing side accepts the technical expert testimony as true.

Only after the trial did respondent substitute persuasive eloquence for testimony in this technical invention—eloquence which, of course, is not subject to cross-examination to establish its errors in physics. The purposes and functions of experts have thus been destroyed.

Accordingly, instead of having a decision based on technical testimony by experts for both sides, there is here a decision based solely on counsel's physics disputing petitioner's expert's testimony.

Petitioner will be able to show that all the other substantial findings and conclusions are either unsupported

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* Here petitioner has borrowed from this Court's language in the *Esnault-Pelterie* case cited by respondent on page 8.

by any testimony, or as is more usual, contrary to the only testimony on the subject.

This is already apparent from respondent's brief. This petition is based on the contention that the findings and conclusions can find no support in the testimony.

Respondent spent the first seven pages summarizing the findings but made no attempt to refer to any testimony to show support of any one of these findings.

2. Respondent at this stage of the case belatedly seeks to inject a new issue to the effect that "petitioner's expert was not qualified to establish operation of the accused structure in terms of the claims". (Respondent's brief, page 8, line 3 from bottom.)

The record shows that petitioner's expert, an electrical engineer and a registered patent attorney, has for more than twenty years prosecuted numerous patent applications on electronic technical inventions. (Record pages 132, 133, 632-634.)

Further diversion is now undertaken by respondent in its brief, page 9. Here it undertakes to show that the petitioner's expert relied on an earlier witness. A full reading of the witness' testimony in the petition, page 5, shows respondent is in error here.

In any event, respondent agrees that this testimony on the presence of the "potential means * * *" is, undisputed. (Respondent's brief, page 8, line 21.)

3. Respondent asserts that petitioner "seeks nothing more than to have this court review the record and to hold * * * infringement" (page 7, line 16, respondent's brief).

Rather petitioner has asked for a rule of law, namely that in complex technical inventions as here, the finder of facts is bound by undisputed testimony and the findings must be supported by testimony. If this Court agrees with

this rule of law, it would seem that the case would then be remanded to the Court of Claims for findings and conclusions in accordance with such a rule of law.

Respondent's brief does not anywhere discuss this issue in the framework of a complex technical invention.

4. Had the Court considered validity, it would have learned from the prior art that the "potential means . . ." in the output circuit for alternatively starting and stopping the electrical discharge was an old and "essential" element of all gas arc discharge tubes, including the Government's gas tubes. That is why its presence in respondent's devices was not disputed.

A Court, it would seem, must review the prior art in order to learn the meaning of terms necessary to properly pass on infringement. Since it must review prior art, it has to go through the process of considering validity. While these steps may be avoided in a simple non-technical invention, this procedure is necessary in a complex technical invention.

Accordingly, petitioner has raised the second issue that where, as here, a complex technical invention is involved, the Court as a matter of law should first consider validity. Respondent does not discuss this precise issue.

Respectfully submitted,

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